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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/931,607	08/16/2001	George E. Bittner	050438-302286	9611

28264 7590 11/04/2002

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EXAMINER

NGUYEN, HOANG M

ART UNIT	PAPER NUMBER
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3748

DATE MAILED: 11/04/2002

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/931,607

Applicant(s)

BITTNER, GEORGE E.

Examiner

Hoang M Nguyen

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 18 September 2002.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-79 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-79 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892) 4) ☐ Interview Summary (PTO-413) Paper No(s). _____
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948) 5) ☐ Notice of Informal Patent Application (PTO-152)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____ 6) ☐ Other: _____

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Applicant's amendment dated September 18, 2002, has been fully considered.

Applicant has argued that none of the applied references, i.e., Schur, Yates and Morgan, disclose elastic wall for expanding and contracting. The examiner strongly disagrees because the examiner fails to understand the basis of applicant's argument. Schur discloses bellows 70-84, Yates discloses diaphragms 24, and Morgan discloses diaphragms 30. Said bellows and diaphragms are clearly expanding and contracting in response to the temperature of the working fluid. On page 4, lines 21-22, of this application, applicant clearly discloses that his first wall 15 and second wall 22 are elastic membrane, diaphragm, or bladder (bellows). Thus, the bellows and diaphragm in the applied references clearly meet the claimed limitation. If applicant decides to maintain his argument, please point out the differences structurally between the flexible walls in the applied references and his walls.

Applicant has provided many other arguments such as "Applicant's walls do not expand/contract in the longitudinal direction, the first and second wall are expandable in the convex and concave direction, Schur does not teaches an expansible chamber where inner and outer walls are outwardly or inwardly expandable, Yates does not disclose the first wall push the second wall..etc..". The examiner is very surprised about these arguments because these limitations are not in the claims, especially in independent claims. It's unclear why applicant attempts to argue about the structures that are not even in the claims. The specification is not the measure of the invention. Therefore, it doesn't matter applicant is right or wrong, the claims are

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still rejected because those limitations are not in the claims. In the claims, applicant simply recites “an elastic wall communicating with the chambers for expanding and contracting when the fluids expand or contract”. All three applied references meet this claimed limitation.

For the reasons set forth above, this Office Action has been made final.

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless -

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 1-9, 11-16, 18-28, 30-35, 37-50, 52-78 are rejected under 35 U.S.C. 102(b) as

being anticipated by U.S. 4121420 (Schur).

Schur discloses a heat engine comprising a heating side (40) expansion chambers (58), and cooling side (upper chamber) expansion chamber (52-54), elastic walls in forms of bellows (70-84) for expanding and contracting in response to the temperatures, support member 30 for supporting said chambers for rotations, inside each tank (50-64) is the refrigerant 94 which can be expanded and contracted, and the weights of said liquid provide the shift off-center balance to rotate the whole apparatus. Regarding the concept of different output motions such as reciprocating, linear, it's well known to convert the output of the shaft to different motions.

Claims 1-78 are rejected under 35 U.S.C. 102(b) as being anticipated by U.S. 4051678 (Yates).

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Yates discloses a heat engine comprising a heating side expansion chambers , and cooling side expansion chamber, elastic walls in forms of diaphragms (24) for expanding and contracting in response to the temperatures, support member for supporting said chambers for rotations, inside each tank 22 is the refrigerant which can be expanded and contracted, and the weights of said liquid provide the shift off-center balance to rotate the whole apparatus. Pipes 34 for connecting and shifting fluid from one tank to the other. Regarding the concept of different output motions such as reciprocating, linear, it's well known to convert the output of the shaft to different motions.

Claims 1-78 are rejected under 35 U.S.C. 102(b) as being anticipated by U.S. 4074534 (Morgan).

Morgan discloses a heat engine comprising a heating side expansion chambers , and cooling side expansion chamber, elastic walls in forms of diaphragms (30) for expanding and contracting in response to the temperatures, support member for supporting said chambers for rotations, inside each tank 21 is the refrigerant which can be expanded and contracted, and the weights of said liquid provide the shift off-center balance to rotate the whole apparatus. Pipes 22 for connecting and shifting fluid from one tank to the other. Regarding the concept of different output motions such as reciprocating, linear, it's well known to convert the output of the shaft to different motions.

THIS ACTION IS MADE FINAL. Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

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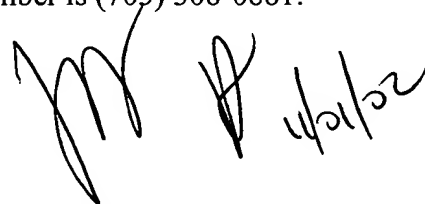
A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Examiner Nguyen whose telephone number is (703) 308-3477. The examiner can normally be reached on Monday--Thursday from 7:30 AM to 6:00 PM.

Any inquiry concerning any general questions regarding patent examining policies and procedures should be directed to Patent Assistance Center (PAC) at 800-PTO-9199 or (703)-308-HELP (703)-308-4357, or Customer Service of TC 3700 at (703) 306-5648.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Thomas Denion, can be reached on (703)-308-2623. The fax phone number for the Examiner is (703) 746-4559.

Any inquiry of a general nature or relating to the status of this application should be directed to the Group receptionist whose telephone number is (703) 308-0861.

A handwritten signature in black ink, appearing to read 'H. Nguyen', followed by a date '11/1/02'.

HOANG NGUYEN
PRIMARY EXAMINER
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Hoang Minh Nguyen
November 1, 2002